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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,401	09/28/2001	Martin Rosner	US 010423	4396

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EXAMINER

HENNING, MATTHEW T

ART UNIT PAPER NUMBER

2131

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/966,401	Applicant(s) ROSNER ET AL.	
	Examiner Matthew T. Henning	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-22 is/are pending in the application.
4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) 1-11 and 14-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 19-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This action is in response to the communication filed on 02/04/2005.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 19-22, is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a method of verifying the correctness of content, classified in class 713, subclass 200, subject matter further including means or steps for increasing a system's extension of protection of system hardware, software, or data from maliciously caused destruction, unauthorized modification, or unauthorized disclosure to or by an end user.
 - II. Claims 19-22, drawn to a method of determining if use restrictions exist for content, including the use of watermarks, classified in class 713, subclass 193, subject matter wherein unauthorized access to information held in static memory elements is prevented.
3. Inventions I. and II. are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I. has separate utility such as determining if a content file has been modified from its original state, if it is correct, or if it contains errors. Invention II. has separate utility such as determining the usage rights of a particular content file. See MPEP § 806.05(d).

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

6. This application contains claims 19-22 drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

7. Claims 1-11 and 14-18 have been examined, claims 12-13 have been cancelled, and claims 19-22 have been withdrawn from consideration.

8. All rejections and objections not set forth below have been withdrawn.

Title

9. The title of the invention is acceptable.

Priority

10. The application has been filed under Title 35 U.S.C §119, claiming priority to provisional application 60/279639, filed March 29, 2001.

11. The effective filing date for the subject matter defined in the pending claims in this application is March 29, 2001.

Information Disclosure Statement

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12. The information disclosure statements (IDS) submitted on 09/28/2001 and 10/10/2003 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Drawings

13. The drawings filed on 09/28/2001 are acceptable for examination proceedings.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites the limitation "the initial three minutes" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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17. Claims 1, 3, 4, 7, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by van Zoest et al. (US Patent Number 6,496,802) hereinafter referred to as van Zoest.

18. Claim 1 recites a method of preventing an attack on a screening algorithm, the method comprising the steps of: identifying content to be downloaded (See van Zoest Col. 5 Lines 39-40); determining a total number of sections of a predetermined duration of time in the content to be downloaded (See van Zoest Col. 8 Lines 64-66 and Col. 12 Paragraph 6); and screening a predetermined number of sections of the total number of sections to determine whether the predetermined number of sections verify correctly through the screening algorithm wherein the predetermined number of sections is a function of a characteristic of the content (See van Zoest Col. 8 Paragraph 7 – Col. 9 Paragraph 1).

19. Claim 3 recites that the screening algorithm relies on a sampling of data contained within the identified content (See van Zoest Col. 8 Paragraph 7 – Col. 9 Paragraph 1).

20. Claim 4 recites that the identified content is downloaded from the Internet (See van Zoest Col. 3 Lines 20-25 and Col. 5 Lines 39-45).

21. Claim 7 recites the step of determining a total length of time of the content prior to the screening step (See Van Zoest Col. 12 Paragraph 6).

22. Claim 10 recites that the predetermined number of sections to be screened is a function of a duration of time for the content (See van Zoest Col. 16 Lines 31-40).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

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subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 2, 5, 6, 8, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Zoest as applied to claim 1 above, and further in view of SDMI (“SDMI Portable Device Specification, Part I, Version 1.0” and “Amendment 1 to SDMI Portable Device Specification, Part I, Version 1.0”) hereinafter referred to as SDMI1 and SDMI2 respectively, and further in view of applicant admitted prior art.

Although van Zoest disclosed a processor, memory, and software (See van Zoest Col. 5 Lines 7-20, and 46-50, and Col. 13 Line 65 – Col. 14 Line 3) for screening music content prior to allowing download of the content (See rejection of claim 1 above), van Zoest failed to disclose the screening including an algorithm specified by the SDMI, and further failed to disclose the number of screened sections generally increasing as the length of the content increased.

SDMI1 and SDMI2 teach a standard for screening music content in order to implement copyright protection on the content (See SDMI1 Sections 1 and 2). This screening includes screening sections of 15-second duration until a phase one trigger is found in a section (See SDMI2 Section 6.1.2), and screening 2 sections (See SDMI1 Sections 6.1 and 6.2 and Applicant admitted prior art Page 7 Lines 12-18).

It would have been obvious to the ordinary person skilled in the art the time of invention to employ the teachings of SDMI1 And SDMI2 in the screening process of van Zoest by following the SDMI screening standard. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide a larger marketplace for the

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customers of the music downloading site and to protect the rights of the content owners by conforming to the SDMI standard.

25. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over van Zoest as applied to claim 1 above, and further in view of Hillis (US Patent Number 6,028,936).

Although van Zoest disclosed a method for screening music content prior to allowing download of the content (See rejection of claim 1 above), van Zoest failed to disclose that the number of sections screened was dependant on the desire of security versus performance. van Zoest did, however, disclose that the number of sections screened could be determined by any algorithm (See van Zoest Col. 8 Line 63 – Col. 9 Line 5).

Hillis teaches that when sampling media, the size of the samples should be determined based on the level of security desired, and that the greater the size, the better the security, but the longer the verification takes (See Hillis Col. 4 Lines 60-67).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Hillis in the sample screening system of van Zoest. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the customers of the site with the best service while still providing adequate copyright protection.

26. Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of van Zoest and SDMI as applied to claim 8 above, and further in view of Serret-Avila et al. (US Patent Number 6,785,815) hereinafter referred to as Serret-Avila.

Although van Zoest disclosed the number of sections to be screened depending on the time of the content (See rejection of claim 10 above), van Zoest failed to disclose incrementing the number of sections screened by one for every predetermined length of the content.

Serret-Avila teaches that in order to protect data content each block should contain the signature of the previous block, and signature in each block should be checked in order to verify the authenticity of the previous block (See Serret-Avile Col. 12 Paragraph 3).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the block signatures of Serret-Avile in the music verification system of van Zoest. This would have been obvious because the ordinary person skilled in the art would have been motivated to ensure that the user of the music access system had authentication for all blocks of the content downloaded.

Response to Arguments

27. Applicant's arguments filed 2/4/2005 have been fully considered but they are not persuasive. Applicant argues primarily that:

- i. van Zoest failed to disclose a screening algorithm or attacks on a screening algorithm.
- ii. van Zoest failed to disclose determining the number of sections to verify as a function of a characteristic of the content.

28. In response to applicants' argument i., the recitation "of preventing an attack on a screening algorithm" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does

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not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the case of claims 1 and 14, the recited steps in the claim bodies have been fully addressed above and it is be noted that the claim bodies fail to provide any limitation related to an attack or its prevention.

Therefore, the examiner does not find the argument persuasive.

29. In response to applicant's argument ii., with respect to claim 1, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., determining the number of sections to verify as a function of a characteristic of the content) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1, instead, clearly recites that "the predetermined number of sections is a function of a characteristic of the content", not the number of predetermined sections. As such, the examiner does not find the argument persuasive, and the argument will not be addressed further with respect to claim 1.

30. Applicants' argument ii., with respect to claim 14, has been considered but is moot in view of the new ground(s) of rejection. Further, in claim 14, not all the sections are screened because sections are screened until a phase one trigger is found.

31. As such, the examiner has maintained the rejections of claims 1-11, and 14-18 as presented above.

32. Also, the examiner notes that the non-elected claims 19-22 fail to comply with the written description requirement. The claim(s) contains subject matter which was not described in the

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specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Conclusion

33. Claims 1-11 and 14-18 have been rejected and claims 12-13 have been cancelled.

34. Claims 19-22 have been withdrawn from consideration.

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Gross et al. (US Patent Number 6,802,003) disclosed a content authentication system for authenticating SDMI content prior to allowing downloading of the content from the Internet.

b. Tso et al. (US Patent Number 6,088,803) disclosed a method for screening files prior to downloading in which blocks of the files, which the size of the blocks depended on the file type, were screened prior to downloading to the final destination.

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

37. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.


The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew Henning
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4/18/2005



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